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PATENT  
ATTORNEY DOCKET NO. 04712/02000F

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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15 JUN 2000

Applicant: Dosuk D. Lee et al.

Art Unit:

Serial No.: 09/284,436

U.S. Filing Date: April 12, 1999

PCT Serial No. PCT/US97/18528

PCT Filing Date: October 16, 1997

Title: BIOCERAMIC COMPOSITIONS

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Assistant Commissioner for Patents  
Washington, D.C. 20231

ATTN: PCT Legal Office

RENEWED PETITION UNDER CFR §1.48(a)

Applicants hereby renew their petition for correction of inventorship under 37 CFR §1.48(a) and request reconsideration on the merits of the petition previously submitted on March 7, 2000, in view of documents submitted herewith.

In reply to the Communication Regarding Declaration mailed April 27, 2000, copies of the following documents are enclosed.

- ☒ Petition To Correct Inventorship - Consent of Assignee
- ☒ Combined Declaration and Power of Attorney under 37 CFR §1.56(a) executed by actual inventors.

In the decision dated April 27, 2000, the Legal Examiner considered the above-referenced Petition under 37 CFR §1.48(a) deficient because (1) the declaration accompanying the petition did not make clear that each inventor signed a complete copy of the declaration; and (2) the written consent of the assignee did not state that Dosuk D. Lee had authority to act on behalf of the assignee, nor did it establish assignee's ownership of the application in accordance with 37 CFR 3.73(b).

Applicants submit that the Combined Oath and Declaration submitted herewith unambiguously makes clear that each inventor signed a complete copy of the document and that the Declaration is proper. Furthermore, the newly executed Written Consent of Assignee includes the requested information and statements.

In view of the supplemental documentation, it is submitted that the Petition to Correct Inventorship is in condition for grant.

If there are any charges, or any credits, please apply them to Deposit Account No. 03-2095.

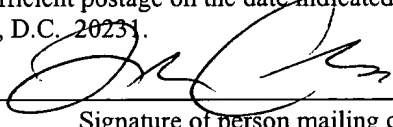
Respectfully submitted,

Date: June 8, 2000

Mary Rose Scozzafava  
Mary Rose Scozzafava, Ph.D.  
Reg. No. 36,268

Clark & Elbing LLP  
176 Federal Street  
Boston, MA 02110  
Telephone: 617-428-0200  
Facsimile: 617-428-7045  
04712.02000F Renewed Petition Under 37 CFR 1.48(a).wpd

PATENT  
ATTORNEY DOCKET NO. 04712/02000F

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| <u>Luis A. Cruz</u>   |  |
| Printed name of person mailing correspondence   | Signature of person mailing correspondence   |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Dosuk D. Lee et al.

Art Unit:

Serial No.: 09/284,436  
PCT/US97/18528

Examiner:

Filed: April 12, 1999

Title: BIOCERAMIC COMPOSITIONS

Director of Patents  
Washington, D.C. 20231

PETITION TO CORRECT INVENTORSHIP -- CONSENT OF ASSIGNEE

As an officer of the concern to which the above captioned application has been assigned, I hereby consent to the correction of inventorship of this application from:

Dosuk D. Lee, Christian Rey, and Maria Aioloa

to:

Dosuk D. Lee, Christian Rey, Maria Aioloa, and Aliassghar Tofighi

**CERTIFICATE UNDER 37 CFR 3.73(b)**

Etex Corporation, a corporation of the state of Delaware, certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of:

An assignment from the inventor(s) of the patent application identified above. The assignment was:

Recorded in the Patent and Trademark Office at Reel 010037, Frame 0197 on June 21, 1999.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.

All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United

States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

ETEX CORPORATION  
38 Sidney Street  
Cambridge, MA 02139

By: Dosuk D. Lee, Ph.D.

Title: Chief Scientific Officer

Signature: 

Date: 5/12/00

27 APR 2000



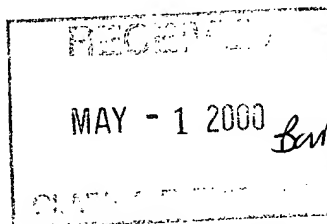
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Boston, MA 02110

In re Application of  
Dosuk D. Lee et al.  
Application No.: 09/284436  
PCT No.: PCT/US97/18528  
Int. Filing Date: 16 October 1997  
Priority Date: 16 October 1996  
Attorney's Docket No.: 04712/02000F  
For: Bioceramic Compositions



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ATTORNEY ATTENTION *mu*

COMMUNICATION  
REGARDING  
DECLARATION

This is a decision on applicants' "Petition to Correct Inventorship Under 37 CFR §1.48(a)" filed on 07 March 2000.

**BACKGROUND**

This international application was filed on 16 October 1997, claiming an earliest priority date of 16 October 1996.

On 15 May 1998, a Demand electing the United States was filed in this international application. Accordingly, the deadline for entering the national stage in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 16 April 1999.

On 12 April 1999, applicants submitted a filing under 35 U.S.C. 371.

On 18 May 1999, a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) were mailed to applicant, requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(e). The Form PCT/DO/EO/917 indicated that the declaration was defective because it was not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.

On 18 June 1999, applicant filed a "Reply to Notification of Missing Requirements," which was accompanied by a "Combined Declaration and Power of Attorney" and a surcharge under 37 CFR 1.492(e).

A Communication was mailed to applicant on 17 February 2000, indicating that the declaration submitted on 18 June 1999 was not in compliance with 37 CFR

1.497(a) in that sheets 2 and 3 of the declaration did not unambiguously identify the specification to which it was directed, and indicating that Aliassghar Tofghi was identified as a joint inventor in the declaration even though he was not named as a joint inventor in the published international application.

Applicants filed the instant petition on 07 March 2000.

### **DISCUSSION**

A grantable petition under 37 CFR 1.48(a) must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part; (2) an oath or declaration by the actual inventor or inventors as required under 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (3) the petition fee set forth in 37 CFR 1.17(i); and (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (*See* 37 CFR 3.73(b)). *See* Section 201.03 of the Manual of Patent Examining Procedure (M.P.E.P.). The petition satisfies requirements (1) and (3) *supra*.

With respect to requirement (2), the declaration accompanying the petition is not in compliance with 37 CFR 1.63 in that it is not clear that each signing inventor signed a complete copy of the declaration, attesting to the information appearing on each of pages 1-3. Rather, in view of the presence of two pages "2 of 3", it appears that at least some of the inventors may have signed only the page(s) bearing their own name(s). Accordingly, it would be inappropriate at this time to grant applicants' request for correction of inventorship.

Regarding requirement (4), the petition is accompanied by a document entitled "Petition to Correct Inventorship- Consent of Assignee." This "Consent" is signed by Dosuk D. Lee, Ph.D., "Chief Scientific Officer" of Etex Corporation. However, as explained at MPEP 201.03, the individual signing such a consent should specifically state that he or she has the authority to act on the behalf of the assignee. In the absence of such a statement, the consent will be accepted if it is signed by an appropriate official of the assignee (such as a president, vice president, secretary or treasurer) if the title is made of record. Regarding the instant case, the position of "Chief Scientific Officer" does not suggest the apparent authority to act on the behalf of the assignee in the sense that such authority is not intrinsic nor is it generally expected to be delegated to the position of Chief Scientific Officer.

Moreover, petitioner has not established the assignee's ownership of the application in accordance with 37 CFR 3.73. As discussed at MPEP 324, "The submission establishing ownership must be signed by a party authorized to act on behalf of the assignee." In this case, the submission is signed neither by a person

in the organization having apparent authority to sign on behalf of the organization nor by a person who avers that he or she is empowered to sign the submission on behalf of the assignee. Furthermore, assignee has not "submitted" the required documentation of a chain of title under 37 CFR 3.73(b) in the sense that the "Consent" signed by Dosuk D. Lee, Ph.D. does not explicitly refer to the documents.


**CONCLUSION**


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ATTORNEY ATTENTION

The petition under 37 CFR 1.48 (a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.

  
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